

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application

Applicant(s): D. A. Brown et al.
Case: 8-1
Serial No.: 10/699,092
Filing Date: October 31, 2003
Group: 2457
Examiner: Hussein A. El Chanti

Title: Internal Memory Controller Providing Configurable Access
of Processor Clients to Memory Instances

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The remarks below are submitted in response to the Notification of Non-Compliant Appeal Brief dated January 7, 2009, in the above-identified application. The Appeal Brief at issue was filed October 21, 2008.

For the reasons identified herein, Applicants (hereinafter “Appellants”) believe that the Notification of Non-Compliant Appeal Brief is improper and should be withdrawn, and that the October 21, 2008 Appeal Brief is in fact compliant with all relevant statutes and regulations.

Notwithstanding the traversal, an Amended Appeal Brief is submitted herewith.

REMARKS

In the Notification of Non-Compliant Appeal Brief, the Examiner objects to the October 21, 2008 Appeal Brief as (i) failing to refer to the specification by page and line number for each limitation in independent claims 1 and 20 and (ii) failing to contain a concise explanation of dependent claims 10-16 which are allegedly argued separately in the brief.

As a preliminary matter, Appellants respectfully note that only dependent claims 11-15 are argued separately in the Appeal Brief. Moreover, in a telephone interview with Appellants' attorney David E. Shifren (Reg. No. 59,329) on Friday, February 6, 2009, the Examiner agreed that the October 21, 2008 Appeal Brief did in fact refer to the specification by page and line number for each limitation in independent claims 1 and 20, and accordingly withdrew this objection. However, the Examiner maintained the objection to the October 21, 2008 Appeal Brief for failing to contain a concise explanation of the separately-argued dependent claims.

The relevant regulation governing the summary of claimed subject matter in an Appeal Brief is 37 C.F.R. §41.37(c)(1)(v), which provides as follows with emphasis supplied:

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

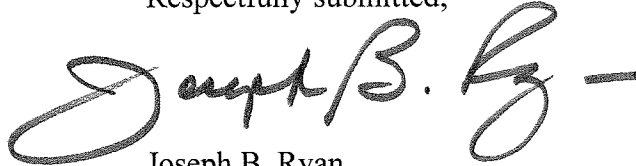
The Examiner, in objecting to the summary with regard to the dependent claims, apparently relies on the second sentence of 37 C.F.R. §41.37(c)(1)(v), containing the underlined portion above. However, it is clear that this sentence as applied to separately-argued dependent claims

only requires that every means plus function and step plus function be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. Dependent claims 10-16, including separately-argued dependent claims 11-15, do not include any means plus function or step plus function recitations. Accordingly, Appellants submit that the summary provided in the October 21, 2008 Appeal Brief is proper and fully compliant with 37 C.F.R. §41.37(c)(1)(v).

The Notification of Non-Compliant Appeal Brief is therefore believed to have been issued in error, and should be withdrawn.

Notwithstanding the traversal, Appellants submit herewith an Amended Appeal Brief, which refers to the specification and drawings with regard to separately-argued dependent claims 11-15, thereby complying with the subjective preference of the Examiner.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Joseph B. Ryan", followed by a horizontal line.

Date: February 9, 2009

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